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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/012,003	10/29/2001	Jeffrey Schulhoff		1696
42534	7590	07/20/2006		
BORDEN LADNER GERVAIS LLP 1100-100 QUEEN ST OTTAWA, ON K1P 1J9 CANADA			EXAMINER OGDEN JR, NECHOLUS	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/012,003	SCHULHOFF ET AL.	
	Examiner	Art Unit	
	Necholus Ogden	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 16 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 16 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The specification objected to as failing to provide proper antecedent basis for the claimed subject matter is withdrawn for claim 29.

1. Claims 1,16 and 19-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeer et al (5,750,733) is withdrawn in view of applicant's amendment.

2. Claims 1,16 and 19-29 rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neal, Jr. is withdrawn in view of applicant's amendment.

Information Disclosure Statement

3. The information disclosure statement filed 10-29-01 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The aforementioned claims states "free of hydrochloric acid", however, applicant does not provide support for this assertion.

Clarification and/or corrections are required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The aforementioned claims states the phrase "substantially free of" which is considered indefinite because applicant does not provide any support for what is meant by "substantially free". Does this mean less than 5.0% or less than .005%?

Clarification and/or corrections are required.

Claim Objections

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 16, 16, 20, 22, 24, 26 and 28 require 90-99.0% by

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weight of a cleaning solution portion, however, the specification does not provide support for this limitation. Appropriate clarification and/or corrections are required.

Response to Arguments

9. Applicant's arguments filed 3-22-05 have been fully considered but they are not persuasive.

Applicant argues that O'Neal, Jr. does not teach compositions that are free of hydrochloric acid nor the advantages of not using hydrochloric acid as recited in the amended claims.

The examiner contends that O'Neal, Jr. does suggest hydrochloric acid as an option, but teaches away from the use of hydrochloric acid, due to its corrosive nature, in the preferred embodiment and suggest the use of sulfuric or phosphoric acid (col. 3, lines 14-16).

Applicant argues that O'Neal, Jr. does not teach the use of sulfamic acid as a base component.

The examiner respectfully disagrees and contends that O'Neal, Jr. teaches that sulfamic acid is one ingredient that may be admixed with peracetic acid (col. 3 lines 4-8), wherein one of ordinary skill in the art would have been motivated to add sulfamic acid to produce the cleansing compositions in view of the teachings disclosed in O'Neal, Jr. Moreover, it is held that "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different

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problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant". In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

New Rejection

10. Claims 1,16 and 21-28 rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neal, Jr. (6,051,108).

O'Neal, Jr. disclose a cleaning solution for processing equipment comprising one or more acids such as 0.0001 to about 1% by weight of a peracetic acid; 0.2 to 30% by weight of an organic acids such as sulfamic and phosphoric in said solution; 0.001 to about 10% by weight of a surfactant in said solution; and 0.1 to about 30% by weight of a glycol ether in said cleaning solution (see col. 3, lines 1-16; Tables and claims 1-23).

11. O'Neal, Jr. lacks a specific example with each of the ingredients in the claimed amounts, however, O'Neal, Jr. teaches each of the claimed ingredients in their requisite proportions within the four corners of said reference, and one of ordinary skill in the art would have been motivated to combine the components to exemplify the claimed invention.

12. Claims 1 16, 19-28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Monticello et al (6,106,774).

Monticello et al disclose a disinfecting compositions comprising at least 1.5% by weight of hydrogen peroxide (col. 6, lines 65-67); 1.0-5.0% by weight of one or more acid such as sulfamic, glycol, citric and phosphoric (col. 7, lines 1-18); and a buffer such

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as citric acid (col. 8, lines 55-60). Monticello et al further includes inhibitors and dyes (col. 8, lines 1-25). See examples and claims.

As this reference teaches all of the instantly required it is considered anticipatory.

In the alternative, if the above listed claims are not anticipated they would have nonetheless been obvious to one of ordinary skill in the art to combine the components comprising hydrogen peroxide, sulfamic acid and an additional acid such as glycolic, phosphoric and/or citric in view of the teachings disclosed in Monticello et al, absent a showing to the contrary.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-T, Th-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Necholus Ogden
Primary Examiner
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No
7-15-2006